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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/011,977 | 06/15/1998 | HERMANN P.T. AMMON | 015200-054 | 1580 |

21839 7590 06/11/2003

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| EXAMINER |
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OWENS JR, HOWARD V

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| ART UNIT | PAPER NUMBER |
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1623

DATE MAILED: 06/11/2003

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/011,977

Applicant(s)

AMMON ET AL.

Examiner

Howard V Owens

Art Unit

1623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

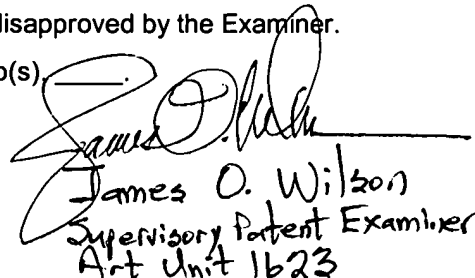
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 10,12-22,24,25 and 27-29.


Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____


James O. Wilson
Supervisory Patent Examiner
Art Unit 1623

The rejection of claims 10, 12-16, 18-22, 24-25 and 27-29 under 35 U.S.C. 103 is maintained for the reasons of record. The base/target of the diseases treated that applicant claims is inflammation, therefore, regardless of the severity of these diseases, one of skill in the art would still be motivated to use boswellic acid for the treatment of the inflammation based diseases per the teachings of Ammon and Mulshine. Newly amended claims reciting "treating" the destruction of functional tissue as opposed to "prevention" would require further search and/or consideration and invoke a 35 U.S.C. 112(1) rejection as well, given that the state of the art teaches that "the mere fact that a compound inactivates HLE in vitro is not in itself a guarantee for a physiological role (*Bernstein et al., Progress in Medicinal Chemistry, vol. 31, p. 65, paragraph 2, edited by Ellis et al., 1994)". Given that applicant's sole support for the use of the purported HLE inhibitor boswellic acid is via in vitro data, a 35 U.S.C. 112(1) rejection would be warranted.

* A copy of Bernstein et al., has not been provided because this reference was cited in a PTO 1449 submitted 4/2/02.


James O. Wilson
Supervisory Patent Examiner
Art Unit 1623